

## **REMARKS**

It is respectfully submitted that the present amendment presents no new issues or new matter and places this case in condition for allowance. Reconsideration of the application in view of the above amendments and the following remarks is requested.

### **I. Response to Prior Amendment**

Applicants acknowledge with appreciation the Examiner's entry of the amendments and withdrawal of the prior rejections.

### **II. Election/Restriction**

The Examiner states that claims 70-74 presented in the 19 May 2009 response are drawn to a non-elected invention and are withdrawn from consideration. Applicants have amended herewith the status identifiers of these claims to reflect their status as withdrawn. Applicants further acknowledge the Examiner's designation of finality of the prior restriction requirement.

### **III. Double Patenting: Non-Statutory**

Claims 57-60 and 65-69 stand provisionally rejected on the grounds of nonstatutory obviousness-type double patenting as being unpatentable over claims 17, 19-22 and 24-29 of copending application no. 11/482,424 ("the '424 application") in view of a variety of references. This rejection is respectfully traversed.

While Applicants respectfully disagree with the Examiner's conclusions regarding obviousness-type double patenting, in the interest of expediting prosecution, Applicants nevertheless stand prepared to submit a Terminal Disclaimer over the '424 application upon the allowance of the instant claims. Applicants respectfully request that the non-statutory obviousness-type double patenting rejection be held in abeyance until the instant claims are otherwise allowable.

Reconsideration is respectfully requested.

### **IV. The Rejection of Claims 57-63 and 65-69 under 35 U.S.C. 103**

Claims 57-63 and 65-69 stand rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over Roggen et al., US 2005/0181446 ("Roggen et al. '446"), and any of Brode et al., USPN 6,599,730, USPN 6,436,690, USPN 6,455,295 or USPN 6,475,765 (collectively "Brode et al" and referenced by the Examiner with respect to the teachings of USPN 6,599,730 "Brode et

al. '730") in view of Poulouse et al., USPN 6,482,628 ("Poulouse et al., '628"). This rejection is respectfully traversed.

"Section 103 forbids issuance of a patent when 'the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.'" *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 298, 406 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, and (3) the level of skill in the art. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). The Supreme Court stated that "[o]ften, it will be necessary for a court to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue." *KSR*, 550 U.S. at 418. The Court also noted that "[t]o facilitate review, this analysis should be made explicit." *Id.* at 418. (Citing *In re Kahn*, 441 F.3d 977, 988 (Fed Cir. 2006) ("[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness"))).

The pending claims are directed to subtilase variants comprising particular modifications, i.e., a substitution at position 9 with Arg and a substitution at position 62 with Asp.

In contrast, however, the Examiner's analysis does nothing more than to combine a number of general statements in the cited references in an attempt to show all of the elements of the claimed invention, without explaining what would have prompted one to combine the elements in the way the claimed invention does. Such general statements lack the specificity required to support a legal conclusion of obviousness and are thus insufficient to establish *prima facie* obviousness. See *KSR* ("A patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the art . . . it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed invention does."). Applicants respectfully submit that the references fail to give any reason to combine the elements identified by the Examiner in the way the claimed invention does, i.e. a reason to make the specifically claimed subtilase.

For the foregoing reasons, Applicants submit that the claims overcome this rejection under 35 U.S.C. 103. Applicants respectfully request reconsideration and withdrawal of the rejection.

#### **V. The Rejection of Claim 64 under 35 U.S.C. 103**

Claim 64 stands rejected under 35 U.S.C. 103 as allegedly being unpatentable over Roggen et al. '446 and any of Brode et al. and Poulouse et al. '628 as applied above and further in view of Fano et al., USPN 6,727,085 ("Fano et al. '085"), Branner et al., USPN 5,482,849 ("Branner et al. '849"), Hansen et al., USPN 6,555,355 ("Hansen et al. '355") and Ghosh et al. USPN 6,831,053 (Ghosh et al. '053"). This rejection is respectfully traversed.

As previously stated, the pending claims are directed to subtilase variants comprising particular modifications, i.e., a substitution at position 9 with Arg and a substitution at position 62 with Asp.

The Examiner's analysis, however, does nothing more than to combine a number of general statements in the cited references in an attempt to show all of the elements of the claimed invention, without explaining what would have prompted one to combine the elements in the way the claimed invention does. Such general statements lack the specificity required to support a legal conclusion of obviousness and are thus insufficient to establish *prima facie* obviousness. See *KSR* ("A patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the art . . . it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed invention does."). Applicants respectfully submit that the references fail to give any reason to combine the elements identified by the Examiner in the way the claimed invention does, i.e. a reason to make the specifically claimed subtilase.

For the foregoing reasons, Applicants submit that the claims overcome this rejection under 35 U.S.C. 103. Applicants respectfully request reconsideration and withdrawal of the rejection.

#### **VII. Conclusion**

In view of the above, it is respectfully submitted that all claims are in condition for allowance. Early action to that end is respectfully requested. The Examiner is hereby invited to contact the undersigned by telephone if there are any questions concerning this amendment or application.

All required fees were charged to Novozymes North America, Inc.'s Deposit Account No.

50-1701 at the time of electronic filing. The USPTO is authorized to charge this Deposit Account should any additional fees be due.

Respectfully submitted,

Date: January 5, 2010

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